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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/630,493

07/30/2003

David Leigh Trigg

AA-541MC

9684

27752

7590

05/05/2008

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EXAMINER

GEMBEH, SHIRLEY V

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

05/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,493

Applicant(s)

TRIGG ET AL.

Examiner

SHIRLEY V. GEMBEH

Art Unit

1614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/5/08 has been entered.

The response filed **2/5/08** presents remarks and arguments to the office action mailed **10/5/07**. Applicant's request for reconsideration of the rejection of claims in the last office action has been considered.

Applicant's arguments have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of claims

Claims 1-27 are pending.

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Claims 1-11 and 13-20 are examined in this office action and claims 21-27 remain withdrawn by restriction election practice.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is a written description rejection the

A lack of adequate written description issue arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) (a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not "reasonably lead" those skilled in the art to any particular species); *In re Ruschig*, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967).

An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure,

other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics.

In particular, the specification as original filed fails to provide sufficient written bases of the derivatives of ascorbic acid and vitamin B3. The scope of the claims includes numerous structural variants, and the genus is highly variant because a significant number of structural differences between members of the genus is permitted. Concise structural features that could distinguish structures or compounds within the genus from others is missing from the disclosure.

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406.

A "representative number of species" means that the species which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus. The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if

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the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]."

Maintained Claim Rejections - 35 USC § 112

Applicant again argues that the rejection should be withdrawn and that the terms serve as approximation and is clear to one of ordinary skill in the art.

The term "about" permits some tolerance which is argued correctly, however, from about and atleast about are indefinite as the skilled artisan would not know the precise range to follow for example from indicates a specific starting point and about does not give that specificity. When used together makes it confusing to the skilled artsan. The same is applied to atleast about.

This is found unpersuasive because "from about" is vague and indefinite and the rejection and explanation above is explicit.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1-11 and 13-20** remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "from about", "at least about" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, because one of skill will not be able to determine which term is in control. The claims

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lack clarity as to whether "from" (a lower limit) or "about"(broadening limitation, both higher and lower) controls the metes and bounds of the phrase "from about". Regarding "at least" (a lower limit) or about "(broadening limitation, both higher and lower), it is unclear what controls the metes and bounds of the phrase "at least about".

Claim Rejections - 35 USC § 103

Applicant argues that the Ha et al., does not teach the now amended claim invention. This is persuasive, however, the combination of newly cited coupled with the old references of record is being made.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims **1-11, and 17 -19** remain rejected under 35 U.S.C. 103(a) as being unpatentable over Deckner et al., US 2003/0113356 taken with Ha et al., US 5,997,887, taken with Jacquier, US 6,337,066, and Okamura, EP 0063875, in view of Masuda et al., US 4, 076, 663, taken with Bengs et al., US 6,548,075 and Zatz et al., J. Pharmaceutical Science (Abstract Only). **(New reference Deckner is added, all other references are of record)**

Deckner et al teach a preformed cosmetic device for delivering agents to the skin having atleast one surface (side) coated. See abstract. The reference also teaches the preformed substrate is made into a gel sheet by using gelling agents wherein the polymeric gellants are water insoluble (see 0036). Further, the reference teaches these substrates can be chosen from a wide variety of materials such as non-woven materials see 0127 as required by instant claim 11 and 13. The preferred viscosity of the liquid medium coating composition is greater than 1,000 mPas, preferably greater than about 5,000 mPas, more preferably greater than 7,000 mPas see 0056. Some disclosed benefit agents include niacinamide (i.e. Vitamin B3) and ascorbic acid see 0079 and [0089] and humectant (0093) and fragrance (perfume) (0131) respectively (instant claims 7-10). Further, the reference teaches the addition of metallic oxides, see 0074 as required by instant claim 4 and the occluded side of the substrate is laminated, see 0125. Para. 0141 teaches a plastic film as required by instant claim`15. with regards to instant claims 17-19 and 20 the reference teaches the exact size will depend on the intended use and can be shaped in a square, semicircular, retangle oval, rings, teardrops etc with size ranging from 1 cm, see 0027-0029.

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Examiners understanding of occlude is to block or close.

The reference fails to teach resistant starches per say although it teaches the inclusion of starches in the composition see 0047.

Ha et al. teach a liquid composition comprising reflective particulate material, wherein the reflective particulate has a particle size of 100 nm (see col. 3, lines 5-10), a water soluble thickening agent wherein the thickening agent is xanthan gum, as in claims 1 and 6 (see col. 11, lines 26-27). Xanthum gum is used as a non-gelling agent for controlling viscosity and has a very high –low sheer viscosity (as evidenced by Zatz et al. see abstract) and is a polymeric thickening agent. According to s evidence by Zatz et al. the viscosity of xanthan is 10^{-3} to 3.3×10^{-3} thus is within the claim limitation. Also, the Ha et al. reference teach the viscosity value is 1 cps = 0.001 Pa·s = 1 mPa·s and the viscosity of these thickening agent is 50-70,00 cps, which is within the instant claim limitation having a viscosity of 1000mPa.s-700,000 (see col. 11, lines 40, 56-60 and col. 18 lines 65-67). Further, see column 5, lines 26-27, where the aqueous carrier is water. The skin tone changing agent is about 0.01 %-2% falls within the limitation of claim 2 see col. 3, lines 6-8 and has having a particle size of 100 nm (see col. 3, line 8), as in claims 3 and 4. The particulate material is a metallic oxide (see col. 3, line 15).

The reference also teaches the mask composition contains vitamin C (ascorbic acid (see col. 27, lines 63-64) and vitamin B₃ (see col. 25, lines 65-67), as in the current claim 8, a humectant (see col. 24, lines 1-2), as in the instant claim 9, as a moisturizing agent. One of ordinary skill in the art would have been motivated to add a humectant to

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the composition because it adds moisture to the skin and does not leave the skin dry after the mask is removed. With regard to claim 5, the reference teaches starch is condensed with long chain alcohol to form resistant starch (see col. 19, lines 39-41), wherein the C8-30 having a sugar moiety (see col. 19, lines 40-42) connected via an ether linkage on the other end with a fatty alcohol to aid in dispersing the one phase (discontinuous) to the other phase (continuous) is disclosed as a dispersion characteristics. (Note this is a non-starch polysaccharide). Therefore, one of ordinary skill in the art would have been motivated to use such a starch that would not only bind the components together but will also protect the face. The reference uses starch polymers (see col. 19, lines 39-41), such as glycosides. By definition, resistant starch is defined as starch that is not absorbed in the small intestine. Note that polyglycosides are formed by linking the carbohydrate moiety by $\alpha(1\rightarrow4)$ bonds. Therefore, the starch used in the reference is a resistant starch (see explanation of a resistant starch above). Resistant starches are not digested in the small intestine but pass to the large bowel for fermentation a non-starch polysaccharide (see abstract), as evident by Nils-Georg Asp (1987, vol. 9 (1) Abstract only). The reference is supplied as evidence only.

Jacquier teaches the use of resistant starch under the name resistamyl-E2 (see col. 2, line 42), as required by instant claim 5, in a cosmetic formulation for treating skin. One of ordinary skill in the art would have been motivated to use a resistant starch in a mask because Jacquier teaches its conventional use in a cosmetic formulation.

Okamura teaches a cosmetic face mask having a water- insoluble substrate that is made of a non-woven material (see page 5, lines 15-18), such as cotton yarn,

synthetic material, as in claims 1 and 11. The reference also teaches a water-insoluble substrate that is configured to cover the majority of the facial area (see first page of the reference diagram), as in claims 17 and 19, as a single piece (see diagram). The reference also teaches (see page 7, lines 1-10) other agents or components that are included in the mask, such as a humectant. With regard to claim 18, the specific dimension is not taught, but the reference teaches paper. Paper falls within the claim limitation of 18 (see pg. 5, lines 5-10) having a thickness from 100 μm to 1 cm.

Bengs et al. teach polysaccharide products in cosmetics (see col. 1, lines 22-50). These polysaccharides have been used to treat skin to produce a pleasant feel (see col.1, lines 49 and col. 10, lines 9-24). Note that Ha et al. teach the formation of these non-starch polysaccharides.

It would have been obvious to one of ordinary skill in the art, at the time the claimed invention was made, to include a mask that has an occluded side as the substrate because using claims 11, 13 to 14 describes the occluded water insoluble substrate as a cotton, pulp and or rayon therefore, the combined teaching of Deckner et al. with the cited references make *prima-facie* obviousness in the instant application. Okamura further teaches that these face masks can be used without washing the face. Leaving flakes on the face (see page 7, line 20-30). opens sweat glands, depending on the material used (as a hot pack), gives a high refreshing effect (see page 8, lines 1-20) and can be used for a wide range of applications. For example, if the facial mask is used to unclog the pores, reduce puffiness or replace moisture back to the skin, one of ordinary skill in the art would have been motivated to use a facial

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mask that has a water insoluble substrate as cotton yarn or rayon material that has embedded into it a liquid composition. When applied to the face, it adheres and dries and can be peeled off easily without making a mess or flakes to unclog pores, reduce swelling or puffiness and replace moisture. As evidenced by the cited prior art, adding perfume to the composition, as taught by Masuda et al., will maintain their effects for a longer time when the resins are impregnated with them, especially with the use of agricultural product (see col. 5, line 65 bridging col. 6, lines 1-2). One of ordinary skill in the art would have been motivated to combine the above cited references to achieve the claimed subject matter, because where Deckner fail per say to identify the starches as resistant starch, Jacquier does. Thus one of ordinary skill in the art would have been motivated to prepare have a mask comprising a water-insoluble substrate, a liquid composition a water-soluble thickening agent for consistency and an aqueous carrier for the reasons already addressed above.

Double Patenting

Claim 1 – 11 and 13-20 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 - 13 of U.S. Patent Application No. **10622518**. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reasons are as follows:

Both the claims of the co-pending applications and that of the instant application are to a mask composition, wherein the instant claims recite a mask composition comprising a hydrophobic –water-insoluble substrate which can be, fabric, paper a thickening agent, an aqueous carrier. The copending application recites a mask composition comprising:

- (1) a water insoluble substrate; and
- (2) an emulsified liquid composition comprising:

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- (a) an oily component;
- (b) a hydrophilic surfactant;
- (c) a water-soluble thickening polymer that provides the liquid composition a viscosity of from about 500mPa-s to about 60,000mPa-s; and
- (d) an aqueous carrier.

Since the term "comprising" is used, the claims are interpreted as having the components that are missing in any one of the claims. One of ordinary skill in the art would be motivated to modify the facial mask add or remove agent depending on the purpose.

The claims of the co-pending application is an obvious variation of the claims of the instant application.

In view of the foregoing, the copending application claims and the current application claims are obvious variations.

Applicant argues that the analysis employed in an obviousness type double patenting parallels to the 103, that claim 1 has been amended, therefore the claims fail to teach the limitation set forth.

In response this is found not persuasive as can be seen from the 103 rejection above, the occluded substrate is within the claim invention.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and co-pending application are claiming mask composition, and method of treating the facial skin using the mask composition. There is overlap with respect to the ingredients, i.e., a thickener, humectant, and whitening agent. The expression "comprising" and the expression "comprising" in the

co-pending application render both sets of claims open to the inclusion of any number of additional active agents. The substrate claimed is same in both the applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claim is allowed.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIRLEY V. GEMBEH whose telephone number is (571)272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SVG

4/16/08

/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614

